

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

John C. Harvey and James W. Cuddihy

Serial No. 08/486,258

Filed: June 7, 1995

For: **SIGNAL PROCESSING APPARATUS
AND METHODS**

Examiner: Luther, W.

Group Art Unit: 2731

Atty. Docket. 05634.0357

BOX: FEE AMENDMENT

Assistant Commissioner of Patents
and Trademarks
Washington, D.C. 20231

RECEIVED
SEP 29 2000
TECH CENTER 2700

**AMENDMENT AND REQUEST FOR RECONSIDERATION UNDER
37 C.F.R. § 1.111**

Table of Contents

I. AMENDMENTS.....	4
A. TO THE SPECIFICATION.....	4
B. TO THE CLAIMS	5
II. REMARKS.....	118
A. INTRODUCTION.....	118
1. Claim Accounting	119
2. Summary of Office Action Rejections	122
B. SUMMARY OF CLAIM AMENDMENTS.....	132
C. STATEMENT OF PATENTABLE NOVELTY UNDER 37 C.F.R. § 1.111	176
D. RESPONSE TO ALLEGATION OF DEFECTIVE OATH/DECLARATION	177
E. RESPONSE TO OBJECTION TO THE SPECIFICATION	179
F. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 112	179
1. Response to Rejections under §112, first paragraph.....	179
a) Response to Written Description Rejections	179
(1) The Office Action Fails to Establish a Prima Facie Rejection Under the Written Description Requirement of 35 U.S.C. § 112	181
(2) Applicants' Summary and Description of Integration of the Instant Specification.....	183
(a) "One Combined Medium" (pages 19-28).....	186
(b) "The Signal Processor" through "The Normal Transmission Location" (pages 28-86) and "The Preferred Configuration of Controller, 39, and SPAM-Controller, 205C." (pages 156-162).....	186
(c) "Operating Signal Processor Systems ... Introduction" through "Operating Signal Processor Systems ... Signal Record Transfer" (pages 86-278)	186

(d)	"Regulating the Reception and Use of Programming ... including Example #6" and "... Example #7" (pages 278-312) as well as "... More on Example #7 ... Combining ... Automatically to the Computer System ..." (pages 427-447).....	189
(e)	"Monitoring Receiver Station Reception and Operation" (pages 312-324)	189
(f)	"Automating Intermediate Transmission Stations" (pages 324-390) including "Example #8" (pages 340-354).....	190
(g)	Examples #9 and #10 (pages 354-390 & 469-516): "Automating Intermediate ... Station Combined Medium Operations" (pages 354-374 of Example #9) and "Network Control of Intermediate Generating and Embedding" (pages 374-390 of Example #10)	191
(h)	Automating Ultimate Receiver Stations (pages 390-427) ... Regulating Station Environment (pages 396-406) ... Coordinating a Stereo Simulcast (pages 406-419) ... Receiving Selected Programming (419-427).....	194
(i)	More Disclosure in the Context of "Wall Street Week" (pages 427-469)	194
(j)	More on Example #7 (pages 427-447).....	195
(k)	Controlling Combined Medium Operations (pages 447-457)	195
(l)	Transmitting Program Instructions Sets (pages 457-463).....	196
(m)	Audio Overlays and Other Overlays (pages 463-468).....	196
(n)	Examples #9 and #10 Continued - Viewer/Listener Station Functionalities (pages 469-516).....	196
(o)	Preprogramming Receiver Station Operating Systems (pages 516-532) and The Preferred SPAM Header (pages 532-533).....	197
(p)	The General Case ... Summary Example #11 (pages 533-557)	198
(q)	Conclusion.....	199
(r)	The Subject Matter in the '81 Disclosure is Specifically Included In the Instant Specification.....	200
(3)	35 U.S.C. § 112 Includes No Requirement That Identical Embodiments of the Invention be Described in Both a Parent Application and a Subsequent Application Claiming Priority Therefrom.....	202
(4)	Conclusion	203
b)	The Specification Enables One Skilled in the Art to Make and Use the Invention	203
(1)	"Digital" is Enabled by the Specification	205
(2)	"Data" is Enabled by the Specification	207
c)	The Best Mode of Practicing the Claimed Invention Contemplated by Applicants is Disclosed in the Specification.....	212
2.	<i>The Claims Comply With 35 U.S.C. § 112, second paragraph</i>	215
a)	The Claims Define That Which Applicants Regard as Their Invention	216
b)	There is no discrepancy in the use of the term "Programming"	217
G.	RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 102	220
1.	<i>Rejection under 102 (b) over Applicants' U.S. Pat. Nos. '490 & '725</i>	220
H.	RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 103	222
1.	<i>Prima Facie Case of Obviousness</i>	222
2.	<i>Rejection under 103 (a, b & e) over Applicants WO 89/02682</i>	222
3.	<i>Rejection over Greenberg, U.S. Pat. No. 4,547,804 in view of Galumbeck et al., U.S. Pat. No. 4,725,886</i>	223
4.	<i>Rejection over over Jeffers et al., U.S. Pat. No. 4,739,510</i>	225
5.	<i>Rejection over Hazelwood et al., U.S. Pat. No. 4,025,851 in view of the publication "System and Apparatus for Automatic Monitoring Control of Broadcast Circuits" by Yaname et al. and Hetrich, Australian Patent No. 74,619</i>	228
a)	Characterization of References	228
(1)	Hazelwood et al	230
(2)	Yaname et al.	230
(3)	Hetrich	230
b)	Absence of Comparison of Cited References with Applicants' Claim Language.....	232
c)	Office Actions Improper Motivation for Combining References	234
(1)	Improper Combination of Hazelwood et al. in view of Yaname et al.	234
(2)	Improper Combination of Hazelwood et al. and Yaname et al., further in view of Hetrich.....	235
6.	<i>Rejection over either one of the common subject matter suggested by Campbell et al., (WO 81/02961, abandoned parent application no. 135,987, and U.S. Pat. No. 4,536,791), in view of at least one or more of: Breeze "Television Line 21 Encoded Information and It's Impact on Receiver Station Design"; Schnee, U.S. Pat. No. 4,290,142; and Zaboklicki, DE 2,904,891</i>	236
a)	Office Action's Failure to Identify Applicants Claim in the Rejection.....	236

b)	Rejection further in view of Zaboklicki.....	239
7.	Rejection further in view of one or more of: <i>Hazelwood et al.</i> , <i>Yaname et al.</i> , <i>Hetrich, Marsden, Young et al.</i> , "Journal of SMPTE" Oct. 1971, U.S. Pat. No. 3,761,888 to Flynn, U.S. Pat. No. 3,627,914 to Davis, Tunmann et al., U.K. Pat. No. 959,374 to Germany, Byloff, Chiddix, Skilton, Schiller et al., Zettl, Vikene, U.S. Pat. No. 4,547,804 to Greenberg, Jeffers et al., Diederich, Campbell et al. (WO 81/02961, abandoned U.S. application no. 135,987, and U.S. Pat. No. 4,536,791), Kazama et al., Gosch, Stern, Breeze, Barlow, Millar, U.S. Pat. No. 4,725,886 to Galumbeck et al., "CBS/CCETT North American Broadcast Teletext Specification," Zaboklicki, U.S. Pat. No. 4,064,490 to Nagel, U.S. Pat. No. 4,251,691 to Kakahara, Hedger et al., Anderson, Gunn, Gaucher, U.S. Pat. No. 4,290,142 to Schnee et al.	245
a)	The Provisional Rejection over Numerous References is Improper	246
b)	Rejection under 35 U.S.C. § 103 is Improper	247
I.	RESPONSE TO EXAMINER'S ADMINISTRATIVE REQUIREMENT	249
J.	RESPONSE TO OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION	250
1.	PTO Assertions in Office Action mailed January 7, 2000	251
2.	The Scope of the Double Patenting Doctrine	252
3.	Patent Office Procedure	253
4.	Nonstatutory Double Patenting	254
a)	Standard for Determining One-Way Obviousness-Type Double Patenting	255
(1)	Identifying the Inventions Claimed.....	256
(a)	Scope of the Inventions as Defined by the Claim Language	258
(b)	Proper Use of Specification	260
(c)	Best Mode.....	261
(d)	Means Plus Function	261
(2)	Establishing Variations between the Invention Claimed and the Invention Defined in the Patent Claims 262	263
(3)	Variations Would Have Been Obvious to a Person of Ordinary Skill in the Art.....	266
5.	Conclusion	267
III.	CONCLUSION	267

APPENDIX A	SPECIFICATION SUPPORT TO THE PARENT 1981 APPLICATION AND THE INSTANT APPLICATION
APPENDIX B	PATENTABLE SUBJECT MATTER OF INSTANT CLAIMS OVER APPLICANTS' PATENTED CLAIMS
APPENDIX C	CORRELATION CHARTS BETWEEN THE PARENT 1987 PRIORITY SPECIFICATION AND THE INSTANT 1987 PRIORITY SPECIFICATION
APPENDIX D	GLOSSARY OF DEFINED TERMS TO THE 1987 PRIORITY INSTANT SPECIFICATION

I. AMENDMENTS

The amendments set forth below are made in response to the Non-Final Office Action mailed March 30, 2000. Applicants respectfully request that the Examiner enter the following amendments in the above-captioned application and reconsider the allowability of the application as amended under 37 C.F.R. § 1.111.

A. To the Specification

Applicants request entering the below amendments to the specification.

On page 1, in the paragraph entitled, "Cross-Reference to Related Applications," on the second line, please delete:

"herein incorporated by reference in its entirety".

This text was mistakenly presented in the statement of the chain of priority of the application under 35 U.S.C. § 120. The statement is surplusage as the specification of Application Number 08/113,329 is the identical specification to that of the instant application.

On page 18, line 13, please change "Fig. 6" to -- Figs. 6a and 6b --.

On page 37, line 23, delete both occurrences of "units" and replace both occurrences with -- words --.

On page 37, line 24, delete "words" and replace with -- units --.

On page 37, line 25, delete "words" and replace with -- units --.

The above amendments to the specification are being made to correct typographical errors and to make the sentence consistent with the disclosure. *See,*

Applicants' specification at page 14, line 26 through page 15, line 6. No new matter is added by these amendments.